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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,255	06/09/2005	Maurizio Morandi	METE101NUS	1866
21658 7590 03/17/2009 DYKAS, SHAVER & NIPPER, LLP P.O. BOX 877 BOISE, ID 83701-0877				
EXAMINER				
NGUYEN, CHI Q				
ART UNIT		PAPER NUMBER		
3635				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,255

Applicant(s)

MORANDI, MAURIZIO

Examiner

CHI Q. NGUYEN

Art Unit

3635

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to applicant's amendment filed on 1/23/2009.

Status of Claims

Claims 1-11 are pending.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fibres are oriented predominantly either in a direction parallel to the ribs of the outer faces or in a direction substantially perpendicular to the ribs of the outer faces and a slab must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "3" has been used to designate both the lower face and the holed face . Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 2-11 are objected to because of the following informalities: a claimed preamble for claims 2-11 should read --The panel--instead of "A panel". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, in page 9 the description states "The latter have a diameter from 2-4mm and preferably 3mm, and a pitch from 4-6mm, preferably 5mm; in any case the ratio empty/full should be of about 33%" is not understood because in the claims 1—11, applicant cites "said holes have diameter from 2-4mm and pitch from 4-6mm". What is the latter? and the latter is the holes? and the holes have pitch?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-5 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the thickness". There is insufficient antecedent basis for this limitation in the claim. Claim 5 depending upon the rejected claim 4 is also rejected.

Claim 11 recites the limitation "the ratio". There is insufficient antecedent basis for this limitation in the claim.

In regarding claim 11, a citation "wherein the ratio of empty/full of the face with the holes is about 33%" is confusing and indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 3,908,062 to Roberts.

Claims 1, 2:

Roberts discloses in Figs. 1-4, a panel comprising an insulating core 19/20, two outer faces 21/22 made of metallic sheet (see col. 1, line 26) disposed on opposite sides with respect to said insulating core 19/20, said panel further comprising a cushion of mineral wool 18. Roberts discloses the claimed invention as stated above but does not disclose expressly wherein the cushion of mineral wool interposed between at least one of said outer faces and the insulating core. It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the cushion of mineral wool layer interposed between one of the outer faces and the core layer for its desirable intended use.

Claim 4:

Wherein the thickness of said cushion of mineral wool is between 10 and 50% of the thickness of said panel (see Figs. 1-4).

Claim 5:

Roberts discloses the claimed invention as stated but does not disclose expressly wherein said cushion of mineral wool has a density of between 40 and 200

kg/m³. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have a desirable density for the cushion of mineral wool layer for its desirable application. Furthermore, applicant has not disclosed the criticality of this feature.

Claim 6:

Roberts discloses the claimed invention as stated including the fibres of the cushion layer are predominantly either in a direction of parallel or perpendicular but does not disclose expressly the out faces including ribs. However, on page 4 of the applicant's specification lines 8-9, the applicant admitted that the ribs are well known in the art and do not therefore required more detailed explanation; the motivation for having ribs on the outer faces for enhancing an integrity for the panels.

Claim 8:

Wherein said insulating core comprises a slab of one of the following materials: perlite, extruded polystyrene or expanded polystyrene (see col. 4, lines 25-34).

Claim 9:

Wherein said adjacent face is provided with a plurality of holes defined therethrough (col. 6, line 29).

As best understood, claims 10-11:

Roberts discloses the claimed invention as stated but does not disclose expressly wherein said holes have diameter from 2 to 4 mm and pitch from 4 to 6 mm and wherein the ratio of empty/full of the face with the holes is about 33%. However, this feature would have been a matter of obvious design choice to one of ordinary skill

in the art at the time the invention was made to have different diameter holes and the ratio for its desirable applications. Furthermore, applicant has not disclosed the criticality of this feature.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 3,908,062 to Roberts in view of US Pat. No. 4,441,293 to McQueen et al.

Claim 3:

Roberts discloses the claimed invention as stated but does not disclose expressly wherein said cushion is fixed to the adjacent face by means of adhesive. McQueen et al. disclose a panel 10 including metal outer faces 11 and a cushion mineral wool layer 10 fixed to the faces by adhesive (col. 1, lines 38-44). In view of McQueen et al. it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Roberts an adhesive material as taught by McQueen for stronger bonding between layers.

Claim 7:

Roberts disclose the claimed invention as stated but does not disclose expressly the insulating core is made polyurethane. McQueen et al. disclose a panel 10 including an insulating core comprises a polyurethane or phenolic foam (see col. 2, line 61). In view of McQueen it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the polyurethane core as taught by McQueen for its applicable use and economic reasons.

Response to Arguments

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairdirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

/C. Q. N./
Examiner, Art Unit 3635

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635